

REMARKS**I. Summary of the Office Action**

The Examiner indicated that the oath or declaration is not proper because it does not state that the person making the oath or declaration acknowledges the duty to disclose to the Office all information known to be material to patentability as defined in 37 C.F.R. 1.56. The Examiner requested that the applicant submit an Information Disclosure Statement (IDS) form 1449 of all relevant references, including those cited in the parent application, now US patent no. 5,771,657. The Examiner indicated that the reissue oath/declaration filed is defective because it fails to contain a statement required under 37 C.F.R. 1.175(a)(1) as to applicant's belief that the original patent is wholly or partly inoperative or invalid. The Examiner indicated that the reissue oath/declaration filed is defective because it fails to identify at least one error which is relied upon to support the reissue application. The Examiner rejected claims 1-4, 6-16, 18-31, 33-34, 46-59, 61-76, 78-90, 114-115, 118-123, 148-149, 153-162, 164-165 as being based upon a defective reissue declaration under 35 U.S.C. 251.

II. Summary of Applicants Reply

Applicants have amended the declaration to include a statement under 35 C.F.R. 1.56, a statement required under 37 C.F.R. 1.175(a)(1), and have identified at least one error relied upon to support the reissue application. Further, applicants have included an IDS form 1449.

a) Statement Under 37 C.F.R. 1.56

The Examiner indicated that the oath or declaration is not proper because it does not state that the person making the oath or declaration acknowledges the duty to disclose to the Office all

information known to be material to patentability as defined in 37 C.F.R. 1.56. Specifically, the Examiner noted that “material to examination” is not the same as “material to patentability.”

Applicants have including a statement in the declaration reciting:

I/We hereby acknowledge the duty to disclose to the United States Patent and Trademark Office all information know to be material to patentability as defined in 37 C.F.R. 1.56.

b) Information Disclosure Statement (IDS) Form 1449

The Examiner requested that the applicant submit an Information Disclosure Statement (IDS) form 1449 of all relevant references, including those cited in the parent application, now US patent no. 5,771,657. Applicants have included herewith an IDS form 1449 of all relevant references, including those cited in the parent application, now US patent no. 5,771,657.

c) Statement required Under 37 C.F.R. 1.175(a)(1)

The Examiner indicated that the reissue oath/declaration filed is defective because it fails to contain a statement required under 37 C.F.R. 1.175(a)(1) as to applicant's belief that the original patent is wholly or partly inoperative or invalid. Specifically, the Examiner indicated that a claim cannot claim “more or less” at the same time (i.e. applicant needs to state that they either claimed more or less and not state both). Applicants have included a statement in the declaration reciting:

My original U.S. Patent 5,771,657, which matured from serial number 08/646,016 is partly inoperative or invalid by reason of claiming less than and more than I had the right to claim through error. In addition, this is a broadening reissue application.

d) Failed to Identify At Least One Error

The Examiner indicated that the reissue oath/declaration filed is defective because it fails to identify at least one error which is relied upon to support the reissue application. Specifically, the Examiner indicated that though the error statement refers to terms or phrases in general which have been omitted, there is no reference in any instance to any specific claim or any indication of what the new or amended claims (with specific reference to at least one claim number) have that the original claims lacked. Applicants have included a statement in the declaration reciting:

Original claim 4 was too broad. Claim 4 has been narrowed to recite “corresponding to the prescription order,” “assembly mechanism,” and “bottle removing mechanism.”

Applicants respectfully submit that the Supplemental Declaration for Reissue Application is in condition for allowance.

Reconsideration is respectfully requested.

CONCLUSION

Applicants respectfully submit that, as described above, the cited prior art does not show or suggest the combination of features recited in the claims. Applicants do not concede that the cited prior art shows any of the elements recited in the claims. However, to the extent Applicants have discussed specific elements of the claims, Applicants have merely provided examples of elements in the claims that are clearly not present in the cited prior art.

Applicants strongly emphasize that one reviewing the prosecution history should not interpret any of the examples Applicants have described herein in connection with distinguishing over the prior art as limiting to those specific features in isolation. Rather, Applicants assert that it is the combination of elements recited in each of the claims, when each claim is interpreted as a whole, which is patentable. Applicants have emphasized certain features in the claims as clearly not present in the cited references, as discussed above. However, Applicants do not concede that other features in the claims are found in the prior art. Rather, for the sake of simplicity, Applicants are providing examples of why the claims described above are distinguishable over the cited prior art.

Applicants wish to clarify for the record, if necessary, that the claims have been amended to expedite prosecution and/or explicitly recite that which is already present within the claims as interpreted in view of the specification. Moreover, Applicants reserve the right to pursue the original and/or complimentary subject matter recited in the present claims in a continuation application.

Any claims that have been cancelled are hereby cancelled without prejudice or disclaimer, and Applicants reserve the right to further prosecute these claims in continuing applications. In addition, Applicants have attempted to claim all embodiments disclosed in the present application, and no disclaimer of any embodiments is hereby intended by the presently pending claims.

Any narrowing amendments made to the claims, if any, in the present Amendment are not to be construed as a surrender of any subject matter between the original claims and the present claims; rather merely Applicants' best attempt at providing one or more definitions of what the Applicants believe to be suitable patent protection. In addition, the present claims provide the intended scope of protection that Applicants are seeking for this application. Therefore, no estoppel should be presumed, and Applicants' claims are intended to include a scope of protection under the Doctrine of Equivalents and/or statutory equivalents, i.e., all equivalents that are substantially the same as the presently claimed invention.

Further, Applicants hereby retract any arguments and/or statements made during prosecution that were rejected by the Examiner during prosecution and/or that were unnecessary to obtain allowance, and only maintain the arguments that persuaded the Examiner with respect to the allowability of the patent claims, as one of ordinary skill would understand from a review of the prosecution history. That is, Applicants specifically retract statements that one of ordinary skill would recognize from reading the file history were not necessary, not used and/or were rejected by the Examiner in allowing the patent application.

Applicants also traverse any "Official Notice," "Design Choice," "Admitted Prior Art" or other alleged prior art that the Examiner purports are well know with respect to the claimed combination of the present invention. Applicants disagree and request the Examiner to provide a prior art reference describing any of these features that the Examiner has not provided a prior art reference or an affidavit under 37 C.F.R. Section 1.104(d)(2) providing details of why it would have been obvious. In the absence of either, Applicants request withdrawal of this rejection for these reasons as well.

For all the reasons advanced above, Applicants respectfully submit that the rejections have been overcome and should be withdrawn.

For all the reasons advanced above, Applicants respectfully submit that the Application is in condition for allowance, and that such action is earnestly solicited.

AUTHORIZATION

The Commissioner is hereby authorized to charge any additional fees, which may be required for this Amendment, or credit any overpayment to Deposit Account No. 08-0219

In the event that an Extension of Time is required, or which may be required in addition to that requested in a petition for an Extension of Time, the Commissioner is requested to grant a petition for that Extension of Time which is required to make this response timely and is hereby authorized to charge any fee for such an Extension of Time or credit any overpayment for an Extension of Time to Deposit Account No. 08-0219.

Respectfully submitted,

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